



# UNITED STATES PATENT AND TRADEMARK OFFICE

mf

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,501	08/01/2001	Hubert Helaine	Q65593	3234

23373 7590 02/02/2007  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER
----------

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
----------	--------------

2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/918,501

Applicant(s)

HELAINE ET AL.

Examiner

Marcos L. Torres

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Arguments***


1. In view of the Appeal brief filed on 10-27-06, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-2, 9 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Buhrmann US 6,035,193 in view Shah US 6,029,065.

As to claims 1, 15 and 16, Buhrmann discloses an automatic network services management method comprising: connecting a communication terminal of a first network is connected to a private base (see col. 1, lines 6-9), connecting said private base is connected to a second network (see fig. 1; col. 3, lines 29-39), and a memory establishing service codes of said first network (see col. 7, lines 57 –col. 8, line 10). Buhrmann does not specifically disclose the memory establishing correspondence. In an analogous art, Shah discloses the memory establishing correspondence (see col. 3, lines 35-40; col. 7, lines 4-17). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to combine the Shah and Buhrmann

Art Unit: 2617

teachings for the simple purpose of compatibility between networks (see Shah col. 1, lines 5-10).

As to claim 2, Shah discloses the method of using a correspondence memory in the communication terminal (see col. 4, lines 1-9)

As to claim 9, Shah discloses the method wherein said correspondence memory is updated between a call of between the terminal and the first network (see col. 10, lines 31-35).

As to claims 12 and 13, Shah discloses the method wherein said first network is a mobile telephone network and second network is a terrestrial telephone network (see col. 1, lines 14-17).

As to claim 14, Shah discloses the method wherein said mobile communication terminal is automatically connected to said private base when said terminal is within range of said base (see col. 6, lines 40-44).

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and further in view of Sipilä (EP 0748136A1).

As to claim 3, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is in said private base. In an analogous art, Sipilä discloses the method wherein said correspondence memory is in said private base (see col. 2, lines 3-11; col. 9, lines 27-52), therefore allowing the updated features be used in legacy terminal. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for the simple purpose of compatibility with old terminals.

Art Unit: 2617

6. Claims 4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Sipilä as applied to claim 3 above, and further in view of Kasmperschroer (U.S. Patent US006434399B1).

As to claim 4, Shah the method wherein: a request corresponding to a service is composed from said communication terminal (see col. 9, lines 1-3), said request is sent from said communication terminal and received at said private base (see col. 9, lines 13-15). Shah does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network, or wherein said request is updated in said private base as a function of said correspondence memory. Sipilä discloses wherein said request is updated in said private base as a function of said correspondence memory (see col. 9, line 26 - col. 10, line 3). Sipilä does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network. Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Sipilä method to ensure compatibility in the connection.

As to claims 6 and 7, Kasmperschroer disclose processing of said request by an operator managing said services of said second network (see col. 7, lines 6-24). Shah discloses the method wherein an acknowledgement is received at said communication terminal or private base (see col. 11; lines 13-22). Therefore, it would have been

Art Unit: 2617

obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of confirms the delivery of data.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Sipilä and further in view of Kasmperschroer as applied to claims 4 and 6-7 above, and further in view of Vanden Heuvel (U.S. Patent US005924014A).

As to claim 5, Sipilä discloses the method wherein, if said correspondence data contains no match to said request sent by said communication terminal send an error message (see col. 9, lines 13-17). Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24). Sipilä and Kasmperschroer do not specifically disclose transmitting without changing the format. Vanden Heuvel discloses transmitting without changing the format (see col. 10, lines 16-21). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the modified Sipilä and Kasmperschroer method for the simple purpose of compatibility.

8. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Kasmperschroer.

As to claim 8, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is updated during a call between said private base and an operator. In an analogous art, Kasmperschroer the method wherein said correspondence memory is updated during a call between said private base and an operator (see col. 7, lines 6-24),, thereby allowing to updated the

Art Unit: 2617

services between the system. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for enhanced compatibility between systems.

As to claims 9, Shah discloses the method wherein said correspondence memory is updated automatically (see col. 6, lines 40-45).

As to claim 11, Shah discloses the method wherein said updating is triggered by a user (see col. 10, lines 46-48).

As to claim 10, Shah discloses the method wherein said correspondence memory is updated periodically. However, OFFICIAL NOTICE IS TAKEN THAT the technique of updating memory periodically it is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple reason of refresh the memory cycle and preserve the data.

### ***Conclusion***

Any response to this Office Action should be mailed to:

U.S. Patent and Trademark Office  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

571-273-8300

for formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:



Art Unit: 2617

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcos L Torres  
Examiner  
Art Unit 2617

mlt

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER